

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-23 are now present in this application. Claims 1, 11 and 12 are independent. By this Amendment, claims 1, 11 and 12 are amended, and claim 23 is added. No new matter is involved. Support for the amendments to claims 1, 11 and 12, and for new claim 23, is found throughout the Application as originally filed, including the drawings, main body of the specification, and originally filed claims.

Reconsideration of this application is respectfully requested in light of the aforementioned claim amendments and remarks.

Personal Interview

Applicants acknowledge with appreciation the courtesies extended by Examiners Lonsberry and Parra to their representative, Mr. Robert J. Webster, Reg. No. 46,472, during the personal interview conducted on October 7, 2008. During that interview agreement was reached to the effect that claims 1, 11 and 12, as amended above, appear to patentably define over Daniels. The Examiners indicated this position would be reconsidered, and an update search made upon the filing of this Amendment with a Request for Continued Examination (RCE).

Rejection Under 35 U.S.C. § 102

Claims 1-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent Application Publication 2003/0074672). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof, it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the *Administrative Procedure Act*, 5 U.S.C. § 706(A), (E) (1994). See *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. See *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. See *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1, as amended, positively recites a combination of features, including separating AV broadcast signals and data broadcast signals from digital television broadcast signals of at least one channel to be provided to respective ones of a plurality of display units; selectively mixing the AV broadcast signals and the data broadcast signals to be provided to the respective ones of the plurality of display units according to a display setup request inputted by an input unit; providing selectively mixed signals directly to a first display unit connected to the network but without using the home network; and providing selectively mixed signals via the home network to at least one display unit other than the first display unit and other than the input unit.

Claim 11, as amended, positively recites a combination of features, including separating AV broadcast signals and data broadcast signals from digital television broadcast signals of at least one channel to be broadcast to respective ones of a plurality of display units in response to an display setup request inputted by an input unit; selectively mixing the AV broadcast signals and the data broadcast signals to be broadcast to the respective ones of the plurality of display units according to the display setup request; providing selectively mixed signals directly to a first display unit; and providing selectively mixed signals via a home network to at least one display unit other than the

first display unit and other than the input unit.

Claim 12, as amended, positively recites a combination of features, including a processing means for separating AV broadcast signals and data broadcast signals from digital television broadcast signals of at least one channel to be provided to respective ones of a plurality of display units; an input means for inputting a display setup request; a mixing means for selectively mixing the AV broadcast signals and the data broadcast signals to be provided to the respective ones of the plurality of display units according to the display setup request inputted from the input means; a home network; a first display means for displaying selectively mixed signals directly from the mixing means; and at least one display means other than the first display means and other than the input means for displaying selectively mixed signals via the home network.

Agreement was reached at the aforementioned interview that Daniels does not disclose or suggest the features positively recited in claims 1, 11 and 12, as amended.

For at least these reasons, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Daniels.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-22 are respectfully requested.

New Claim 23

Claim 23 has been added for the Examiner's consideration. Applicants submit that claim 23 depends from independent claim 1, and is allowable at least because claim 1 is allowable, for reasons presented above.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By: Esther H. Chong
Esther H. Chong
Reg. No.: 40,953
BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000
Attorney for Applicants